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EXAMINER

MCCULLEY, MEGAN CASSANDRA

ART UNIT

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1796

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ELECTRONIC

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Response to Arguments

The amendments to the claims are entered since they place the application in better form for appeal by materially reducing and simplifying the issues for appeal.

The objection and rejection of newly canceled claim 22 are removed. The remaining rejections set forth in the final stand.

Applicant's arguments filed October 7, 2009 have been fully considered but they are not persuasive.

A) Applicant's argument that Wang et al. does not disclose the specific emulsion aggregation method of the instant application but instead teaches a phase inversion method is not persuasive. The phase inversion method disclosed in Wang et al. comprises each of the claimed method steps. As set forth in paragraph 10 of Wang et al., the process occurs in an aqueous dispersion (lines 1 and 11-12). The process comprises the step of producing an epoxy containing particle (para. 10 line 13). This step reads on the aggregating step in that small molecules of epoxy functional resin and a polymer having acid groups are made to come together to form larger entities. Since there are no size limitations recited in the claims, this particle producing step is the same as aggregating particles to form aggregated particles. The coalescing step occurs in paragraph 41 where a component is added to facilitate the coalescence of the water dispersible epoxy containing particles. Since any additional steps that distinguishes the emulsion aggregation process from the phase inversion process are not claimed, the prior art teaches the claimed process. Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

B) Applicant's argument that Wang et al. teaches the zirconium sulfate as a crosslinking agent instead of an aggregating agent is not persuasive. The Court in *KSR* stated that it is an error for patent examiners to look only to the problem the patentee was trying to solve. (550 U.S. at ___, 82 USPQ2d at 1397 and MPEP 2141 II A 2). Although Wang et al. teaches adding the compound for a different purpose, the compound is still present with the other claimed compounds and used in the claimed process. There are no guidelines found in the claims as to the amount of the aggregating agent that would cause the compound to only function as an aggregating agent and not a crosslinking agent. Therefore, the compound would behave in the same way as in the instant process.

C) Applicant's argument that Wang et al. does not teach step b) is not persuasive. As set forth above and in the final Office action, the coalescing step occurs in paragraph 41 where a component is added to facilitate the coalescence of the water dispersible epoxy containing particles. Limitations from the specification are not read into the claims.

D) Applicant's argument that Wang et al. do not establish adding a curing agent after the coalescing step is not persuasive. Paragraph 41 discloses it is preferable to add a hydrophilic polymer to facilitate the coalescence of the particles in the overcoat composition. Paragraph 53 teaches that the overcoat can contain crosslinking agents.

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Therefore, the overcoat has been preferably coalesced prior to the addition of the curing agent.

E) Applicant's argument that Wang et al. do not establish adding a curing agent before the aggregation step is not persuasive. Paragraph 22 teaches crosslinking agents can be present in the dispersion. As set forth in paragraph 10, the particle forming method/aggregation step occurs in this dispersion. Therefore, the crosslinking agent can be present in the dispersion during the production of the particles.

F) Applicant's argument that a person having ordinary skill in the art would not be motivated to combine the dry-blending step of Davydov with the method of Wang et al. is not persuasive. Davydov teaches the desire to have additional additives in the powder and that dry-mixing is used with conventional powder coating technology (col. 2 lines 25-36). Wang et al. is a powder coating. Therefore, a person having ordinary skill in the art would have been motivated to dry blend to form a more homogenous coating composition.

G) Applicant's argument that a person having ordinary skill in the art would not look to Patel for the teaching of a GSD is not persuasive. A process for making toner compositions is analogous to a process for forming curable powder since toner compositions are curable powder. Furthermore, as set forth above, while Wang et al. teaches a phase inversion process, the steps read on the steps of the claimed emulsion aggregation process. Also, the words emulsion aggregation process does not appear in the claim language, only a process for forming curable powder, with which both Wang et al. and Patel are concerned.

H) Applicant's argument that a person having ordinary skill in the art would not combine the colorant of bichromal spheres of Sacripante with the process of Wang et al. is not persuasive. Sacripante discloses the usefulness of the bichromal spheres and their unique colorant characteristics. Therefore a person having ordinary skill in the art would look to Sacripante to achieve the useful properties of the bichromal spheres when making particles as disclosed in Wang et al.

I) Since claims 1 and 10 are finally rejected and no allowable subject matter is indicated, a rejoinder is not proper at this time.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Megan McCulley whose telephone number is (571)270-3292. The examiner can normally be reached on Monday - Thursday 7:30-6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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